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EXAMINER

PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,388

Applicant(s)

ADAMCZYK ET AL.

Examiner

Joseph T Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 6, 9, and 10 the phrase "the message" lacks antecedent basis as it is not known which message this phrase is referring to as there are two different messages, [i.e. message reviewed in VMS(line 2) or message transmitted by VMS(line 5)].

In lines 10,13, and 15 the phrase "the communication" lacks antecedent basis as there are several different types of communications in claim 9. Appropriate clarification or correction is required.

In line 15, the phrase "the call" lacks antecedent basis as there are several different types of calls in claim 9 and it is not known which call it is referring to.

In line 1, the phrase "the position" lacks antecedent basis.
Appropriate clarification or correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8 rejected under 35 U.S.C. 103(a) as being unpatentable over
Hanson, Patent #5,922,045 in view of Logan et al., Patent #6,199,076.**

Regarding claim 1, Hanson teaches a method for placing a subscriber's communication in a position with respect to a review of messages in a voice messaging program, the method comprising:

in response to an indication from the subscriber's communication to leave the review, creating an identifier to mark the position of the subscriber's communication in the review(210-213 Fig.2A and col.3 line 55-col.4 line 47);

storing the identifier(col.4 lines 47-51);

in response to notice indicating the subscriber's communication is to rejoin the review in the voice messaging program, using the identifier to place the subscriber's communication in the position in the review, whereby a subscriber may interrupt the review of messages in the voice messaging program and then return to the position in the review in the voice messaging program (235-237 Fig.2B and col.5 lines 15-65).

Hanson is silent on using the identifier(bookmark) in a voice mail system(program).

Logan teaches using a bookmark(identifier) in a voice mail program.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Hanson's voice messaging program to include a voice mail program as taught by Logan. One would be motivated to do so as Hanson discloses using bookmarks in a variety of different audio systems(programs) to resume where the user left off for later use(col.1 line 66-col.2 line 30 and col.4 lines 52-55) and

Logan teaches using bookmarks in a voice mail program for later retrieval and use(col.3 lines 42-56 and col.16 lines 29-45) as using bookmarks in a voicemail system would be more efficient to the user b/c he is able to return to the position where he left off as taught by Hanson and Logan. Furthermore, Hanson discloses that accessing audio services is well-known but creating and using a bookmark(identifier) with it isn't(col.3 lines 51-57) and a voice mail system is a well-known audio service.

Regarding claim 2, Hanson in view of Logan teaches the method of Claim 1, wherein the notice comprises a copy of the identifier; and wherein using the identifier to place the subscriber's communication in the position in the review comprises using the copy of the identifier with the identifier to place the subscriber's communication in the position in the review (Hanson 224-232 Fig.2B)

Regarding claim 3, Hanson in view of Logan teaches the method of Claim 1, wherein creating the identifier to mark the position of the subscriber's communication comprises, in response to the indication from the subscriber's communication to leave the review, providing a message indicating a release of the subscriber's communication (Hanson 210-213 Fig.2A)

Regarding claim 4, Hanson in view of Logan teaches the method of Claim 3, wherein the message comprises a remote operations (RO) parameter including a copy of the identifier (Hanson 224-237 Fig.2B).

Regarding claim 5, Hanson in view of Logan teaches the method of Claim 4, wherein the message comprises a GR-1129 message comprising the RO parameter including the copy of the identifier (Hanson 224-237 Fig.2B).

Regarding claim 6, Hanson teaches a method of enabling the placement of a subscriber's communication in a position in a review of messages in a voice messaging program, the method comprising:

receiving a message indicating a voice message program release, of the subscriber's communication by the voice messaging program, the message including a copy of an identifier marking the position of the subscriber's communication in the review of messages in the voice message program (210-213 Fig.2A);

storing the copy of the identifier(213 Fig.2A); and

in response to receiving notice of a release of the subscriber's communication by a network element other than the voice message program, directing the subscriber's communication to be routed to the voice message program including the copy of the identifier (221 and 235-237 Fig.2B).

Hanson is silent on using the identifier(bookmark) in a voice mail system(program).

Logan teaches using a bookmark(identifier) in a voice mail program.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Hanson's voice messaging program to include a voice mail program as taught by Logan. One would be motivated to do so as Hanson discloses using bookmarks in a variety of different audio systems(programs) to resume where the user left off for later use(col.1 line 66-col.2 line 30 and col.4 lines 52-55) and Logan teaches using bookmarks in a voice mail program for later retrieval and use(col.3 lines 42-56 and col.16 lines 29-45) as using bookmarks in a voicemail system would be

more efficient to the user b/c he is able to return to the position where he left off as taught by Hanson and Logan. Furthermore, Hanson discloses that accessing audio services is well-known but creating and using a bookmark(identifier) with it isn't(col.3 lines 51-57) and a voice mail system is a well-known audio service.

Regarding claim 7, Hanson in view of Logan teaches the method of Claim 6, wherein the message comprises a remote operations (RO) parameter including the copy of the identifier (Hanson 224-237 Fig.2B).

Regarding claim 8, Hanson in view of Logan teaches the method of Claim 7, wherein the message comprises a GR-1129 message comprising the RO parameter including the copy of the identifier(Hanson 224-237 Fig.2B).

Allowable Subject Matter

3. Claim 9-12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments

4. Applicant's arguments filed 02/06/04 have been fully considered but they are not persuasive. In response to applicant's argument of claims 1 and 6, that the prior art of record fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "subscriber's communication" is only "a call") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner respectfully disagrees that the phrase "subscriber's communication" can only

be interpreted as a call. Examiner interprets the phrase 'subscriber's communication' as being able to establish one call or multiple calls and services regarding the same type of communication by the subscriber. Therefore the prior art of record still reads on the claimed limitation.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP
April 14, 2004



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